

### REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. New claim 28 is added. Claims 1-28 are pending in this application.

#### 35 U.S.C. § 101

Claims 10-12 and 25-27 are stated in the Office Action (p. 2) to stand rejected under 35 U.S.C. §101. Applicant respectfully traverses and requests reconsideration.

The Office Action states that these claims are directed to non functional descriptive data stored on a medium, but provides no authority for the position taken.

Applicant finds the language "the second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 10. Applicant finds the language "a second data field, correlated through the data structure to the first data field, configured to cause a processor to correlate the second data field with a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 25. The functionality of the second data field is to associate the first data field containing the annotation with the plurality of different versions of the multimedia content to which the annotation corresponds.

Such is a useful, concrete and tangible result, as is described in MPEP 2106, entitled "Patentable Subject Matter - Computer-Related Inventions". This is discussed in more detail in subsection II(A), entitled "Identify and Understand

Any Practical Application Asserted for the Invention". This MPEP section also states that "Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." Accordingly, in the event that the rejection is maintained, Applicant requests clarification of the rejection.

Thus, for at least these reasons, Applicant respectfully submits that claims 10-12 and 25-27 comply with 35 U.S.C. §101. Accordingly, Applicant respectfully requests that the §101 rejections be withdrawn.

### 35 U.S.C. § 103

Claims 1-12 and 25-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Synchronized Multimedia Integration Language (SMIL) 1.0 Specification", W3C Recommendation 15 June 1998, (hereinafter "W3C") in view of U.S. Patent No. 6,332,144 to deVries et al. (hereinafter "deVries"). Claims 13-20 and 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over W3C in view of U.S. Patent No. 6,449,653 to Klemets et al. (hereinafter "Klemets"). Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over W3C and Klemets and further in view of "Media Weaver" by Sha Xin Wei (hereinafter "Wei"). Applicant respectfully submits that claims 1-27 are not unpatentable over W3C in view of deVries, Klemets and/or Wei and requests reconsideration.

Klemets was filed on March 25, 1997 and issued on Sept. 10, 2002. The instant application was filed on Sept. 15, 1999, and a CPA is being filed on an

even date herewith. As such, Klemets qualifies as prior art only under the timing provisions of 35 U.S.C. §102(e).

Klemets is assigned to the Microsoft Corporation, Redmond, WA. The instant application is also assigned to the Microsoft Corporation of Redmond, WA.

As such, Klemets is not available as prior art under 35 U.S.C. 103, as is discussed in more detail in MPEP §706.02(l)(1), entitled "Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103(c)". This MPEP section cites 35 U.S.C. 103(c):

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

More specifically, this MPEP section states that "Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant. patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues."

Accordingly, Klemets is not available as prior art under 35 U.S.C. §103 with respect to this application, and, as such, the rejection of claims 13-20 and 21-24 is prima facie defective. Additionally, no other grounds for rejection have been

lodged regarding claims 13-20 and 21-24. Accordingly, in the event that the Examiner still finds such claims to be not allowable, a subsequent non-Final action must be made with different grounds for rejection.

In traversing the rejections, it is helpful to first review the teachings of the references. Accordingly, brief summaries of W3C, deVries and Wei appear below.

W3C provides a specification for a "Synchronized Multimedia Integration Language" (Title). This language is intended to allow integration of "a set of independent multimedia objects into a synchronized multimedia presentation. Using SMIL, an author can

1. describe the temporal behavior of the presentation
2. describe the layout of the presentation on a screen
3. associate hyperlinks with media objects" (Abstract).

deVries describes a "Technique For Annotating Media" (Title), and teaches that "To annotate media, one or more particular times within a period defined by a start time and an end time of a media stream forming an item of audio or video media, are identified. The identified times are those at which content within the media stream corresponds to an annotation value. The annotation value is associated with the identified times to annotate the media." (Abstract).

Wei teaches "A Distributed Media Authoring System For Networked Scholarly Workspaces" (Title). Wei teaches that this provides "a software framework for composing distributed media in the context of university research and instruction. Authors may compose networked media, software tools and mediastreams, and can freely annotate media by media of any form using schema

of their own design. Faculty and student authors compose distributed media using common Macintosh, World Wide Web and NeXTSTEP applications, supported by services from UNIX workstations." (Abstract).

The Office Action states (p. 2) that W3C discloses a system (p.26, ex. 4) for associating annotations, contained in the <text.../> tag, to the plurality of media streams, representing different versions of multimedia content ... as explained in the header of the example." Applicant disagrees and requests reconsideration.

In this example, <text .../> represents the multimedia content and is not an annotation (see, e.g., the Title of this section - "Choosing between content written for different screens"). Note that no other element is provided that could represent any other media content in this example. Note also that in the immediately preceding example, "<audio .../>" is the syntax, with "..." representing a specific audio source, such as: src="joe-audio-french" system-language ="fr". Ellipsis simply indicates that the argument pointing to the text source is arbitrary in this example.

The Office Action also states (p. 4) that W3C does however disclose that both the annotations and media are referenced by a URI (p. 19, "src"). The Office Action also states (p. 5) that W3C teaches "a data field representing an annotation ...." Applicant respectfully disagrees. W3C is silent with respect to annotations, and the Examiner has admitted this on the record (p. 7).

W3C states (p. 17, §4.2.3, entitled "Media Object Elements") that "ref, animation, audio, img, video text and textstream" are media object elements. W3C further indicates that such media object elements may have attributes such as duration. Such is completely inconsistent with the characterization of such objects

as annotations provided in the Office Action. The Office Action fails to identify any teaching whatsoever of annotation anywhere in W3C.

The Office Action further states (p. 3) that deVries discloses that media and annotations can be stored on servers (Fig. 1B, 22 and 26). Combining such with the teachings of W3C fails to provide "an annotation database, coupled to the multimedia server, that stores a plurality of annotations, wherein each of the plurality of annotations is correlated with different versions of multimedia content contained in the plurality of media streams", as recited in claim 1, any "storage device to store a data structure; and an annotation module to store an annotation in the storage device so that the annotation is correlated with different versions of the same multimedia content via the data structure", as recited in claim 7, any "second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 10, or any "second data field, correlated through the data structure to the first data field, configured to cause a processor to correlate the second data field with a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 25.

In contrast, deVries teaches (col. 2, lines 10-13) that "According to the present invention, an item of audio or video media is annotated by identifying the particular time or times within the period defined by the start and end times of a media stream forming an item of media." There is no teaching, disclosure, suggestion or motivation in either W3C or deVries of any annotation being associated with multiple version of multimedia content.

Accordingly, combining the teachings of the references does not provide the invention as recited in claims 1, 7, 10 or 25. Additionally, there is no teaching or disclosure within the references to guide one of ordinary skill in selecting elements from the references or combining the selected elements.

Claim 13 recites "A method comprising: receiving a user request to create a new annotation; and associating the new annotation with a set of media streams, wherein the set of media streams is part of a plurality of media streams, and wherein each of the plurality of media streams is a different version of multimedia content", which is not taught, disclosed, suggested or motivated by the cited references. W3C is silent with respect to annotations. The word "annotation" does not appear anywhere in W3C. Modifying the teachings of W3C fails to provide the invention as recited in claim 13 and specifically fails to provide "associating the new annotation with a set of media streams", as recited in claim 13.

Claim 20 recites "A method comprising: receiving an indication of a version of media content being presented to a user; identifying a collection of annotations corresponding to the media content, each annotation corresponding to a plurality of different versions of the media content; and providing selected annotations from the collection of annotations to the client computer for presentation to the user", which is not taught, disclosed, suggested or motivated by the cited references. W3C and the Office Action are silent with respect to annotations that each correspond to a plurality of different version of media content, as recited in claim 20.

The unpatentability rejections fail to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2142, entitled "Legal Concept of Prima Facie Obviousness" (see also MPEP §706.02(j)).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20



USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim.

Accordingly, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Inasmuch as there is no guidance within the references to identify which teachings should be selected or how they should be combined, it appears that the rejection is based on an improper "obvious to try" standard. Such is described in more detail below with reference to MPEP §2145(X)(B). This MPEP section states that:

The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted).

No indication as to which parameters are critical and no direction as to which of many possible choices is likely to be successful has been identified in the references relied upon.

Dependent claims 2-6, 8, 9, 11, 12, 14-19, 21-24 and 26-27 are allowable as depending from an allowable base claims and for their own recited features which are neither shown nor suggested by the prior art. For at least these reasons,

Applicant respectfully requests that the §103 rejections of claims 1-27 be withdrawn, and that claims 1-27 be allowed.

### Examiner's Response to Argument

Wh [ The Examiner's response to argument is deficient in multiple regards. A first deficiency is that the response to argument clearly fails to respond to Applicant's arguments with respect to the rejections under 35 U.S.C. §103, or, in the alternative, is an admission that these rejections are defective.

Applicant notes the requirements of MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action". This MPEP section cites 37 CFR §1.104, entitled "Nature of examination" which in turn states, in subsection (b), entitled "Completeness of examiner's action" that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made."

Which arguments have not been considered [ This MPEP section further states, under a heading labeled "Examiner Note" that "The Examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." The Office Action clearly fails to comport with these requirements as set forth in the MPEP, at least because the Office Action both fails to address Applicant's arguments with respect to anticipation and continues to reject claims as being anticipated.

A second deficiency is that the combinations used in the unpatentability rejections fail to provide all of the features recited in any of Applicant's

*When features are ignored*

independent claims. The Examiner has ignored these features without providing any appropriate legal basis for doing so.

A third deficiency is the failure to respond to all arguments traversing the unpatentability rejections. Merely repeating that "it would be obvious" to provide the features recited in the claims does not constitute a basis for rejection of the claims, particularly when the references fail to provide the features recited in the claims and the rejections fail to meet the standards for such rejections as set forth in the MPEP and as demonstrated by Applicant.

A fourth deficiency is to combine the teachings of disparate references absent any guidance in the references to support the combination when main intentions of each of the cited references are defeated by the combination and the Examiner has completely failed to respond to Applicant's repeated legal arguments showing this to be the case.

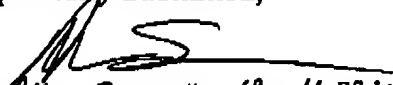
For at least these reasons, the Office Action fails to comport with appropriate standards for examination. The Examiner should either allow Applicant's claims or provide a meaningful basis for rejection and an appropriate response to Applicant's arguments.

**Conclusion**

Claims 1-28 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: 7/1/03

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**Version of Claims with Markings to Show Changes Made**

**In the Claims:**

Claim 28 has been added.

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